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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,212	01/22/2002	Yasuo Nomura	275791US6	4641

22850 7590 01/12/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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WENDMAGEGN, GIRUMSEW

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/054,212		NOMURA, YASUO	
	<b>Examiner</b>		<b>Art Unit</b>	
	Girumsew Wendmamegn		2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/15/2004; 10/26/2006</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 and 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Fujinami et al. (Patent Number US 5,485,280).

Claim 1, Fujinami et al anticipate a recording and playback apparatus for encoding inputted AV signals to produce coded data and recording the coded data onto a randomly accessible recording medium and for playing back and decoding the coded data recorded on the recording medium, comprising: production means for encoding the inputted AV signals using a first coding system to produce first coded data; first recording means for recording the first coded data produced by said production means onto the recording medium (see figure 4 element 3); supervision means for supervising the recording process by said first recording means (see figure 4 element 3); readout means for reading out the first coded data recorded on the recording medium by said first recording means from the recording medium; conversion means for converting the first coded data read out from the recording means by said readout means into second coded data corresponding to a second coding system (see figure 4 element 90); and

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second recording means for recording the second coded data converted by said conversion means onto the recording medium(see figure4 element6) ;said readout means, conversion means and second recording means being operable to execute the respective processes simultaneously with the recording process by said first recording means based on a result of the supervision by said supervision means(see column8 line63-column9 line1-21).

Regarding claim5, Fujinami et al anticipates recording and playback method for a recording and playback apparatus which encodes inputted AV signals to produce coded data and records the coded data onto a randomly accessible recording medium and further plays back and decodes the coded data recorded on the recording medium, comprising: a production step of encoding the inputted AV signals using a first coding system to produce first coded data (see column1 line61-64); a first recording step of recording the first coded data produced by the process of the production step onto the recording medium(see column1 line61-64); a supervision step of supervising the process of the first recording step; a readout step of reading out the first coded data recorded on the recording medium by the process of the first recording step from the recording medium(see column1 line65-66); a conversion step of converting the first coded data read out from the recording means by the process of the readout step into second coded data corresponding to a second coding system(see column1 line65-66); and a second recording step of recording the second coded data converted by the process of the conversion step onto the recording medium(see column2 lines 27-31);

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the processes of the readout step, the conversion step and the second recording step, respectively, being executed simultaneously with the process of the first recording step based on a result of the supervision by the process of the supervision step(see column8 line63-column9 line1-21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim2-4 and 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami et al (Patent Number US 5,485,280) as applied to claim1 and 5 above, and further in view of Seo (Patent Number US 6,798,980).

Regarding claim2, see the teaching of Fujinami et al above. Fujinami does not teach first coding system is the MPEG2 system and the second coding system is the MPEG1 system. However Seo teaches first coding system, MPEG2 and second coding system MPEG1 (see figure1 element 20 and 50). One of ordinary skill in the art at the time the invention was made would have been motivated to use MPEG2 and MPEG1 system as in Seo in to Fujinami et al apparatus because converting MPEG2 to MPEG1 would save storage space.

Regarding claim3, see the teaching of Fujinami et al above. Fujinami does not teach conversion selects one of a process of converting the first coded data read out from the recording medium by said readout means and another process of outputting the first coded data read out from the recording medium by said readout means as they are without converting the first coded data, and said second recording means records the first or second coded data produced by the process selected by said conversion means onto the recording medium. However Seo teaches recording with or without converting the first coded data (see column2 lines 23-44). One of ordinary skill in the art at the time the invention was made would have been motivated to record the coded data as in Seo with or without converting it in to another format because it would allow the user to manage the storage space effectively.

Regarding claim4, see the teaching of Fujinami et al above. Fujinami teaches a recording and playback apparatus according to claim 3, further comprising transfer means for transferring the first or second coded data produced by said conversion means to another electronic equipment (see figure4 7 and 8).

Regarding claim6, see the teaching of Fujinami et al above. Fujinami does not teach program storage medium in which a computer-readable program for encoding inputted AV signals to produce coded data and recording the coded data onto a randomly accessible recording medium and for playing back and decoding the coded

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data recorded on the recording medium. However, It is old and known in the art to record a computer-readable program on storage medium. Therefore official notice is taken. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to record a computer-readable program in to storage medium because it would allow the user to use it many times.

Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alr Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thai Tran  
Supervisory Patent Examiner  
TECHNOLOGY CENTER 2600

Girumsew Wendmagegn